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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,041	04/08/2004	Colin T. Metcalfe	50180	9253
22929	7590	11/29/2006	EXAMINER	
SUE Z. SHAPER, P.C. 1800 WEST LOOP SOUTH SUITE 1450 HOUSTON, TX 77027			ARK, DARREN W	
			ART UNIT	PAPER NUMBER
			3643	

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,041

Applicant(s)

METCALFE, COLIN T.

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,23-41 and 43-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,23-41 and 43, 46-48 is/are rejected.
- 7) ☒ Claim(s) 44 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Inventorship

1. The Examiner would like to indicate that there are issues with the inventorship in this application since the inventors of U.S. Pat. Application 09/736,023 of Howse et al. have not signed and executed the Oath filed 5/17/2004 and that Mr. Colin T. Metcalfe represents an entirely new inventor who was not an inventor on U.S. Pat. Application 09/736,023. Therefore this application cannot be considered to be a properly executed Continuation of U.S. Pat. Application No. 09/736,023.

Claim Objections

2. Claims 44 and 45 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 44 and 45 not been further treated on the merits.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-7, 23-41, 43, 46-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 18-44, 46-48, and 50 of copending Application No. 09/736,023. Although the conflicting claims are not identical, they are not patentably distinct from each other because a method of trapping insects comprising using a particulate composition vs. particles comprising at least one magnetic material in an electromagnetically sensitive material which includes strontium ferrite vs. a magnetic material; a cockroach affecting composition/pesticidal composition in particulate form which includes electromagnetically sensitive particles with a magnetic material which includes strontium ferrite vs. a core being impregnated or coated with a magnetic material; an insect trap having a composition comprising a magnetic material in the electromagnetically sensitive particles which includes strontium ferrite vs. a composition including particles comprising a magnetic material of opposite polarity to that of the magnetically polarized material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 37, 38/37, 39/37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regard to claim 37, the specification and figures do not disclose the composition located upon a surface within the building, drain, or sewer.

7. Claims 37, 38/37, 39/37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regard to claim 37, the specification contains no disclosure of the composition including a building, drain or sewer or any specific structure that the desired invention is to be used with except for the trap.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 32-41, 43, 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 32, the phrase "wherein the at least one pesticide and an insect behaviour modifying chemical includes at least one pesticide and an insect behaviour modifying chemical" renders the claim vague and indefinite since it was recited in lines 2-3 that "at least one of a pesticide and an insect behaviour modifying chemical". Furthermore the phrase "includes at least one pesticide and an insect behaviour modifying chemical other than a food odor chemical" renders the claim vague and indefinite since it is unclear whether the composition includes one of a pesticide and behaviour modifying chemical or one of a pesticide and a behaviour modifying chemical.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 4, 5, 7, 48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Latwesen 6,176,033.

Latwesen discloses a method of controlling insects (method not being particularly claimed) comprising including in the particulate composition (12, 12a-c) at least one

pesticide or insect behavior modifying chemical (fish attractant can include food type attractants as disclosed at col. 3, lines 16-20; fish attractant is capable of altering the behavior of flies or roaches which are attracted to food sources) and at least one magnetized magnetic material (ferromagnetic components comprising one or more of iron, nickel, and cobalt and also magnets themselves); and locating the composition proximate a path of the insect (vessel 10, 10a-c is located at a fishing location which could be in the path of an insect).

In regard to claim 2, Latwesen discloses that small particles can be more easily homogenously dispersed throughout a fish bait than large particles and that the particles having a minimum dimension of greater than 0 inch and a maximum dimension of less about 0.25 inch (see col. 4, lines 43-45; .25 inch=6350 micrometers).

In regard to claim 5, Latwesen discloses the composition comprising at least 10% by weight (see col. 4, lines 45-50) of hard magnetic material ("hard" is a relative term).

In regard to claim 48, Latwesen discloses at least one pesticide or insect behaviour modifying chemical other than a food odor chemical (the fish attractant can have a visible appearance which attracts fish, and can comprise, for example, glitter; glitter comprises chemicals which can not be considered to be food odor chemicals; see col. 3, lines 20-25; also glue or paste is disclosed as being used in the composition and therefore could be interpreted as non-food odor chemical).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3, 5/2, 5/3, 6, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Latwesen 6,176,033.

In regard to claims 3 and 31, Latwesen discloses using ferromagnetic components comprising one or more of iron, nickel, and cobalt and also magnets themselves, but does not disclose the magnetized material comprising a ferromagnetic oxide, strontium ferrite or a ferrosilicate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a ferromagnetic oxide or strontium ferrite, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because ferromagnetic oxides and silicates are materials exhibiting magnetic properties that can be found in particulate form and strontium ferrite is an alloy exhibiting magnetic properties and would be employed by a person of ordinary skill in the art depending upon the ultimately desired composition. *In re Leshin*, 125 USPQ 416.

In regard to claim 31, Latwesen discloses the use of metal filings (hard), powder (hard), powder (hard) trapped in a polymer, and wherein at least some of the magnetizable particles can be in the form of particles of a flexible magnet (soft), but

does not disclose the composition comprising approximately 10% by weight of strontium ferrite and approximately 90% by weight of a ferrosilicate. It would have been an obvious matter of design choice to modify the composition of Latwesen such that the composition comprises approximately 10% by weight of strontium ferrite and approximately 90% by weight of a ferrosilicate, since applicant has not disclosed that by doing so produces any unexpected results and because a person of ordinary skill in the art would readily alter the composition in order to obtain the desired product consistency and characteristics.

Response to Arguments

14. Applicant's arguments filed 10/2/2006 have been fully considered but they are not persuasive.

In regard to applicant's argument that "...traverses the rejection of claim 37....specification original page 1 lines 19-26 together with page 4 lines 14-16 and original claim 4....", the Examiner contends that at page 1, lines 19-26 that the specification merely states that cockroaches thrive in urban situations and are common in heated buildings and that large populations can be found in sewers and drains but nowhere is it stated that the desired invention comprises a system including a building, drain, or sewer. The system is only disclosed as being the trap in combination with the claimed magnetized magnetic material. At page 4 lines 14-16, the specification merely states that the material is applied to a surface where pests are present, but it does not disclose the system including a building, drain, or sewer. Original claim 4 merely recites

that the particles are applied to a surface in an area in which pests are present, preferably a surface which is inclined to the horizontal, but does not particularly claim a system including a building, drain, or sewer.

In regard to applicant's argument that "Latwesen...instant application is a continuation of co-pending SN 09/736,023....", the Examiner contends that the inventorship issues in the present application do not provide the necessary basis for the examiner to consider the present application as being a continuation of co-pending application no. 09/736,023.

Conclusion

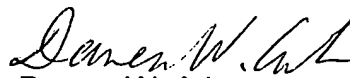
15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (571) 272-6885. The examiner can normally be reached on M-F, 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Darren W. Ark
Primary Examiner
Art Unit 3643

DWA